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EXAMINER

EL HADY, NABIL M

ART UNIT PAPER NUMBER

2152

DATE MAILED: 09/06/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/771,751

Applicant(s)

CHATANI, MASAYUKI

Examiner

Nabil M. El-Hady

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 January 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-26 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

1. Claims 1-26 are presented for examination.
2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

3. Claims 1, 2, 4-9, 17-19, 21, 22 and 24-26 are rejected under 35 U.S.C. 102(e) as being anticipated by Landsman et al. (US 6,314,451) (hereinafter Cohen).

4. As per claim 1, Landsman teaches a system for providing auxiliary content to a client during download of primary content from a server, comprising:

A server network comprising a download management server, a customer database that stores user information, and a primary content database that stores primary content (e.g. col. 6, lines 20-28); a client console connectable for establishing a communications link through a bi-

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directional communications network to the download management server (e.g. col. 6, lines 30-37); and at the client console, local storage for storing a user identifier and auxiliary content, wherein the auxiliary content is stored in the local storage prior to download of the primary content from the download management server (e.g. col. 6, lines 20-32); wherein the user identifier is uploaded from the client console to the download management server, access is enabled to requested primary content in the primary content database, and the auxiliary content stored in the local storage device of the requested primary content (e.g. col. 6, lines 20-40).

5. As per claim 25, it is rejected for similar reasons as stated above.

6. As per claim 2, Landsman teaches the system, wherein the auxiliary content is variable based on a user preference (e.g. col. 9, lines 55-63).

7. As per claim 19, it is rejected for similar reasons as stated above.

8. As per claim 4, Landsman teaches the system wherein the auxiliary content is variable based on a distributor preference (e.g. col. 4, lines 43-52).

9. As per claim 5, Landsman teaches the system wherein the distributor preference is determined first by having the download management server send the client preference data usable to assign content before sending the requested content, and second by having the client console execute the content stored in the local storage according to the preference data (e.g. col. 10, lines 1-12).

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10. As per claim 26, it is rejected for similar reasons as stated above.

11. As per claim 6, Landsman teaches the system wherein the preference data can be selected from one or more individual content choices and one or more content category choices (e.g. col. 10, lines 33-46).

12. As per claim 7, Landsman teaches the system, wherein the auxiliary content can be acquired and distributed to the local storage over the communications network (e.g. col. 10, lines 46-55).

13. As per claim 8, Landsman teaches the system, wherein the local storage is a hard disk drive (e.g. col. 10, lines 43-45).

14. As per claim 9, Landsman teaches the system wherein the client console further comprises a local fixed storage disposed internally or externally of the client, wherein requested primary content is downloaded onto the fixed storage device (e.g. col. 10, lines 5-12).

15. As per claim 22, it is rejected for similar reasons as stated above.

16. As per claim 17, Landsman teaches the system wherein the auxiliary content is selected from the group consisting of images, movies, music, games, customer surveys and lots (e.g. col. 10, lines 1-10).

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17. As per claim 18, Landsman teaches the system wherein information is downloaded from the download management server into the client console to trigger execution of specified auxiliary content items based on comparison with the information (e.g. col. 10, lines 33-46).

18. As per claim 21, it is rejected for similar reasons as stated above.

19. As per claim 24, Landsman teaches the method further comprising a step of continuously surveying to determine whether the client console user overrides playback of said auxiliary content during execution of said primary content (e.g. col. 10, lines 33-46).

20. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

21. Claims 3,10-16, 20 and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Landsman in view of Rakavy et al. (US 5,913,040) (hereinafter Rakavy).

22. As per claim 3, Landsman does not specifically teach the system wherein the client preference is determined by prompting the client to input information settings, and by providing the client with a selection of one or more individual content choices and one or more content category choices. Rakavy teaches the system wherein the client preference is determined by prompting the client to input information settings, and by providing the client with a selection of

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one or more individual content choices and one or more content category choices (e.g. col. 3, lines 34-51). It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine Landsman with Rakavy. The motivation would have been to add interactivity for the purpose of information collection to the system.

23. As per claim 10, Landsman does not specifically teach the system, wherein the auxiliary content is provided on portable storage that stores the auxiliary content and is suitable for mass distribution. Rakavy teaches the system, wherein the auxiliary content is provided on portable storage that stores the auxiliary content and is suitable for mass distribution (e.g. col. 3, lines 15-26).). It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine Landsman with Rakavy. The motivation would have been to add portability to auxiliary content distribution system.

24. As per claim 11, it is rejected for similar reasons as stated above.

25. As per claim 12, it is rejected for similar reasons as stated above.

26. As per claim 13, Landsman does not specifically teach the system, wherein the local storage is a removable storage device installable in the client console. Rakavy teaches the system, wherein the local storage is a removable storage device installable in the client console (e.g. col. 4, lines 60-64). It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine Landsman with Rakavy. The motivation would have been for the local storage device to be removable.

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27. As per claim 14, Landsman does not specifically teach the system wherein said removable storage device includes data structures thereon comprising a plurality of auxiliary content items, a plurality of trigger data items logically associated, respectively, with each of said auxiliary content items, and a user identifier. Rakavy teaches the system wherein said removable storage device includes data structures thereon comprising a plurality of auxiliary content items, a plurality of trigger data items logically associated, respectively, with each of said auxiliary content items, and a user identifier (e.g. col. 10, lines 21-41). It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine Landsman with Rakavy. The motivation would have been for the browser to access the removable drive as it would access the hard disk.

28. As per claim 15, Landsman does not teach specifically the system, wherein said user identifier is uploaded to said download management server to enable access to specified content in said primary content database, and said user information is downloaded into said client console to trigger execution of specified auxiliary content items based on comparison with said trigger data items. Rakavy teaches specifically the system, wherein said user identifier is uploaded to said download management server to enable access to specified content in said primary content database, and said user information is downloaded into said client console to trigger execution of specified auxiliary content items based on comparison with said trigger data items (e.g. col. 12, lines 19-40). It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine Landsman with Rakavy. The motivation would have been to display advertisement based on user preferences triggered by the user.

29. As per claim 16, it is rejected for similar reasons as stated above.

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30. As per claim 20, it is rejected for similar reasons as stated above.

31. As per claim 23, it is rejected for similar reasons as stated above.

32. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nabil M. El-Hady whose telephone number is (571) 272-3963. The examiner can normally be reached on 9:00 - 4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Follansbee can be reached on (571) 272-3964. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

September 2, 2005



Nabil El-Hady, Ph.D, M.B.A.
Primary Examiner
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